Paper No. 15
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UNITED STATES PATENT AND TRADEMARK OFFICE 11/29/00

Trademark Trial and Appeal Board

In re Temps & Co., Inc.

Serial No. 75/321,952

Janice W. Housey and Adam D. Resnick of Piper Marbury Rudnick & Wolfe LLP., for Temps & Co., Inc.

Matthew J. Pappas, Trademark Examining Attorney, Law Office 104 (Sidney I. Moskowitz, Managing Attorney).

Before Cissel, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

On July 10, 1997, applicant applied to register the mark "FUTURES: THE 21ST CENTURY JOB STORE" (with the word "JOB" disclaimed) on the Principal Register for "personnel placement services" in International Class 35. The basis for filing the application was applicant's assertion that it possessed a *bona fide* intention to use the mark in commerce in connection with these services.

Registration was refused under Section 2(d) of the Lanham Act because the Trademark Examining Attorney determined that applicant's mark, if it were used in connection with the services recited in the application, would so resemble the mark

"JOB STORE" (with the word "JOB" disclaimed) which is registered[1] for "employment and job placement services," that confusion would be likely.

Applicant presented arguments in support of its contention that confusion with the mark in the cited registration is not likely. In support of its arguments, applicant argued from Internet excerpts that the term "JOB STORE" is diluted and hence relatively weak as applied to job-related services. Applicant also argues that it is committed to the temporary job market, while registrant's services are directed toward storing online employee resumes of Coloradans looking for permanent jobs. Finally, applicant points out the dissimilarity of the marks as to appearance, sound and overall commercial impression.

The Examining Attorney was not persuaded by applicant's argument or evidence, and made final the refusal to register under Section 2(d) of the Act.

The Trademark Examining Attorney denied applicant's request for reconsideration, and applicant timely filed a notice of appeal, which was timely followed with an appeal brief. The Examining Attorney then filed his brief on appeal, and applicant

[1] Registration No. 1,213,413, was issued on the Principal Register on October 19, 1982 to Alan Grandbois, d.b.a. The Job Store; combined affidavit under Sections 8 and 15 of the Act filed and accepted.

requested an oral hearing before the Board, which was held on May 24, 2000.

We turn then to the issue of whether confusion is likely in view of the cited registered mark. In the course of rendering this decision, we have followed the guidance of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), which sets forth the factors that should be considered, if relevant, in determining likelihood of confusion. In the case at hand, the factors about which we have evidence are the similarity of the trademarks and the relationship between the services of the applicant and the registrant.

We first turn to consider the services. Applicant argues in its brief as follows:

> … Applicant submits that the respective services are not so similar such that there would be confusion between the prior registered mark and its mark. Specifically, Registrant's services focus on finding jobs in Colorado. Applicant's services are of a different nature. Specifically, Applicant's services focus on regular job placement services -- resume writing assistance, and sending applicants to interviews with prospective employers, particularly as these services apply to the temporary employment market, so-called "temp jobs." Hence, Applicant's name is "Temps & Co." which reflects this commitment to the temporary help job market.
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> Registrant's services appear to be focused on the "storing" of job information online for potential employees in Colorado. These potential employees can apply for jobs in the bank of jobs "stored" online. Meanwhile, Applicant's services revolve around the more traditional placement of employees through a "store" of potential employees who can "shop" around for their dream job. In other words, Applicant's "store" is specifically designed for consumers to shop

> around until they are comfortable with a job and its working environment. [Applicant's brief on appeal, pp. 10–11].

However, it is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the services as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the services, their channels of trade and/or classes of purchasers. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Thus, we agree with the Trademark Examining Attorney that applicant's "personnel placement services" would be encompassed within registrant's recitation of "employment and job placement services," and hence are deemed to be identical.

We now turn to a consideration of the parties' respective marks, keeping in mind as well that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America,* 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Registrant has a registration on the Principal Register for the mark "JOB STORE" for "employment and job placement services." In adopting its mark for substantially identical services ("personnel placement services"), applicant has taken

registrant's mark in its entirety, and added "FUTURES: THE 21ST CENTURY …" in front of the words "… JOB STORE."

While there are obvious differences between applicant's mark and registrant's mark as to sound and appearance, we conclude that the marks are similar in overall commercial impression. Registrant's entire mark is the designation "JOB STORE." Applicant's mark contains registrant's mark in its entirety. Reasonable people may differ as to what the dominant portion of applicant's mark is, or indeed, whether this six-word phrase even has a dominant element. However, although applicant argues that "FUTURES: THE 21ST CENTURY …" is the dominant portion of this composite service mark, we agree with the Trademark Examining Attorney that this dependent portion of the mark cannot stand by itself. At oral hearing, applicant argued that consumers may well shorten this phrase to simply "FUTURES" while the Trademark Examining Attorney argued that they would likely shorten it to "JOB STORE." As a registered trademark, the designation, "JOB STORE," stands conceptually as the dominant part of applicant's title. The term "JOB STORE" is at least as dominant as the word "FUTURES" inasmuch as the words "THE 21ST CENTURY" follow the colon and serve as a modifier of "JOB STORE." We think it particularly significant, in this case, that someone acquainted with registrant's services and mark may well view applicant's mark as a modernization or timely

updating of registrant's mark. Applicant, as the latecomer to job-related services, had the duty to select a mark far enough removed from registrant's previously used mark to avoid any confusion. *See e.g.*, *Miles Laboratories, Inc. v. Naturally Supplements, Inc*., 1 USPQ 2d 1445, 1455 (TTAB 1986).

Moreover, as to applicant's claim that this term "JOB STORE" is diluted and weak in this field, we note that the evidence of record does not support the conclusion that third parties have adopted, used or registered this two-word designation apart from other potentially distinguishing matter. Again, we see no reason not to accord the cited, incontestable registration the weight such a mark deserves under the statute.

Decision: The refusal to register under Section 2(d) of the Act is affirmed.

R. F. Cissel

D. E. Bucher

G. F. Rogers

Administrative Trademark Judges,
Trademark Trial and Appeal Board